



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,163	03/16/2004	Ramanathan Kasiviswanathan	200209086-1	4154
22879	7590	01/04/2010	EXAMINER	
HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528		OYEBISI, OJO O		
		ART UNIT		PAPER NUMBER
		3696		
			NOTIFICATION DATE	
			DELIVERY MODE	
			01/04/2010	
			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM  
ipa.mail@hp.com  
laura.m.clark@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* RAMANATHAN KASIVISWANATHAN,  
SUDHEER SADANANDA KURKUNDHI, and  
SRINIVASAN RAMASWAMY

---

Appeal 2009-006278  
Application 10/802,163  
Technology Center 3600

---

Decided: December 30, 2009

---

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R.  
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appeal 2009-006278  
Application 10/802,163

## STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-19 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

## THE INVENTION

The Appellants' claimed invention is directed to method of handling a financial transaction in a transaction switch. Spec. [0004]. Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method of handling a financial transaction in a transaction switch, the method comprising the steps of:
  - receiving a primary transaction request from an initiator;
  - identifying a host from a routing table for receiving the primary transaction request based on details provided in the primary transaction request;
  - transmitting the primary transaction request to the identified host,
  - receiving a response from the identified host,
  - determining a need for transmitting the primary transaction request to another host; and
  - interpreting the response received and transmitting a final outcome back to the initiator.

## THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Ofir                    US 7,219,149 B2                    May 15, 2007

The following rejections are before us for review<sup>1</sup>:

1.     Claims 1-19 are rejected under 35 U.S.C. § 102(e) as anticipated by Ofir.

## THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether the Appellants have shown that Ofir does not disclose the argued claim limitations for each respective claim as specifically argued.

## FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:<sup>2</sup>

FF1.     Ofir discloses a terminal adapter and network for transaction processing. Title.

---

<sup>1</sup> We note that the Examiner has withdrawn the rejections of claims 1-19 made under 35 U.S.C. § 112, second paragraph, at page 7 of the Answer.

<sup>2</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Ofir discloses a message is first sent to a Client Node 25a. The Client Node then determines the appropriate Node to forward the request to. This decision is based on the host name selected by the Terminal Adapter in a transaction protocol. The Client Node selects a route to forward the transaction based on in part, the service name, link capacity, configuration, and processing loading. Assuming the message is forwarded directly to Service Node 25b, the Service Node 25b forwards the transaction to the Financial Transaction Processor 36 according to the protocol used to interconnect the Host 36 and Node 25b. (Col. 30:1-24).

FF3. Ofir at Col. 30:1-20 does not specifically disclose determining the need for transmitting the primary transaction request to another host based on at least one of a payment type in a primary transaction request.

FF4. Ofir at Col. 20:46-66 and Fig. 10 discloses the switch from a primary communication path to secondary communication path. Ofir at Col. 20:46-66 does disclose first and second communication paths, but does not specifically reference a secondary transaction containing reference to a primary transaction and reversing the primary transaction.

FF5. Ofir in Fig. 12 A shows protocol types (VISA-I, VISA-II) and transactions types and different destination hosts.

FF6. Ofir discloses at Col. 29:64-65 that the Terminal Adaptor selects an appropriate service name that identifies the Host processor and transaction type.

FF7. Ofir at Col. 16:60-67 discloses that the Terminal Adaptor determines the appropriate Host to relay the financial transaction information based on information provided by the Network 33.

FF8. Ofir has not specifically disclosed “identifying a transaction request as multi-host” and “means for identifying the transaction request as composite” at Col. 15:1-65, Col. 16:60-67, Col. 30:1-15 and Col. 29:55-65.

## PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

## ANALYSIS

### *Claims 1 and 18*

The Appellants argue that the rejection of claims 1 and 18 is improper because Ofir fails to disclose “determining a need for transmitting the primary transaction request to another host”. Br. 11, Reply Br. 2-3. The Appellants also argue that Ofir does not show the same request “transmitted to another host”. Br. 12.

In contrast, the Examiner has determined that Ofir discloses the claimed limitations at Col. 30:5-20. Ans. 8.

We agree with the Examiner. Ofir discloses a terminal adapter and network for transaction processing. FF1. At Col. 30:1-24 Ofir discloses, that a message is first sent to a Client Node 25a. The Client Node then determines the appropriate Node to forward the request to. The Client Node selects a route to forward the transaction based on in part, the service name, link capacity, configuration, and processing loading. Assuming the message is forwarded directly to Service Node 25b, the Service Node 25b forwards the transaction to the Financial Transaction Processor 36 according to the protocol used to interconnect the Host 36 and Node 25b. FF2. Thus, the Client Node determines which Node to forward the transaction request to based in part, the service name, link capacity, configuration, and processing loading meeting the cited claim limitation. The node to which the request is forwarded may be broadly considered “another host” meeting the cited claim limitation. For these reasons the rejection of claims 1 and 18 is sustained. The Appellants have not argued separately for dependent claims 2-3 and the rejection of these claims is sustained for these same reasons.

*Claims 4, 9 and 17*

The Appellants argue with regard to claim 4 that Ofir does not teach “a secondary transaction containing a reference to the primary transaction” and “transmitting a request reversing the primary transaction” and provides similar arguments for claims 9 and 17. Br. 13-14 and 16.

In contrast, the Examiner has determined that Ofir discloses the cited claimed limitations for claim 4 at Col. 20:50-67 and Fig. 10. Ans. 8-9.

We agree with the Appellants. Ofir at Col. 20:46-66 and Fig. 10 does disclose first and second communication paths but does not specifically

Appeal 2009-006278  
Application 10/802,163

reference a secondary transaction containing reference to a primary transaction and reversing the primary transaction. FF4.

For these reasons the rejection of claims 4, 9, and 17 is reversed.

*Claim 5, 12, and 19*

The Appellants argue that the rejection of claim 5 is improper because Ofir fails to disclose “a plurality of hosts and sending a plurality of packets to the hosts based on the transaction and payment type”. Br. 12-13, 16, Reply Br. 3-5. In contrast, the Examiner has determined that Ofir discloses the cited claimed limitations in Fig. 12A. Ans. 9-10. The Appellants provides a similar argument for claim 12 and 19. Br. 12-13 and 15-16.

We agree with the Examiner. As noted above in reference to claim 1, Ofir discloses that the Client Node then determines the appropriate Node to forward the request to. FF2. The node to which the request is forwarded may be broadly considered “another host” as well meeting the cited claim limitation. Ofir discloses at Col. 29:64-65 that the Terminal Adaptor selects an appropriate service name that identifies the Host processor and transaction type. FF6. Ofir in Fig. 12A shows protocol types (VISA-I, VISA-II which may be broadly considered “payment types”) and transactions types and different destination hosts. FF5. For these reasons the rejection of claims 5, 12, and 19 is sustained. The Appellants have not argued separately for dependent claims 6-8 and the rejection of these claims is sustained for these same reasons.

*Claims 10 and 13*

The Appellants argue that the rejection of claims 10 and 13 is improper because Ofir fails to disclose “identifying a transaction as multi-host or composite”. Br. 15.

In contrast, the Examiner has determined that Ofir discloses the cited claimed limitations because if the information provided to network 33 was multi-host, inherently this transaction would be relayed to the appropriate hosts. The Examiner cites to Ofir at Col. Col. 15:1-65, Col. 16:60-67, Col. 30:1-15 and Col. 29:55-65 as disclosing this feature. Ans. 5-6.

We agree with the Appellants. Ofir at Col. 16:60-67 discloses that the Terminal Adaptor determines the appropriate Host to relay the financial transaction information based on information provided by the Network 33. FF7. Ofir has not specifically disclosed “identifying a transaction request as multi-host” and “means for identifying the transaction request as composite at Col. 16:60-67. FF8.

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’

*In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted). Here the mere fact that Ofir could identify a transaction as “multi-host” or “composite” is not sufficient to establish such structure beyond probabilities or possibilities. For these reasons the rejection of claims 10 and 13, as well as dependent claims 11 and 14-16, is not sustained.

Appeal 2009-006278  
Application 10/802,163

## CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 5-8, 12, and 18-19 are rejected under 35 U.S.C. § 102(e) as anticipated by Ofir.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 4, 9-11, and 13-17 are rejected under 35 U.S.C. § 102(e) as anticipated by Ofir.

## DECISION

The Examiner's rejection of claims 1-3, 5-8, 12, and 18-19 is sustained. The Examiner's rejection of claims 4, 9-11, and 13-17 is reversed.

## AFFIRMED-IN-PART

mev

HEWLETT-PACKARD COMPANY  
INTELLECTUAL PROPERTY ADMINISTRATION  
3404 E. HARMONY ROAD  
MAIL STOP 35  
FORT COLLINS CO 80528